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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/707,792

01/13/2004

Charity Sullivan

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07/28/2006

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EXAMINER

OLSON, MARGARET LINNEA

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/707,792             | SULLIVAN, CHARITY   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Margaret L. Olson      | 3727                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 1/1/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 6 of the specification, the term "lien" is used twice in paragraph 19, and is assumed to be a misspelling.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 3, 4, 6, 7, 9, 10, 11, 12, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Erdmann (US 6,321,958). Erdmann discloses the same invention including a storage compartment 12 with a top 12T, bottom 12B, opposing sides 12S, and an opening in the vicinity of 12T, as well as a storage sleeve of material 14 intended for holding any cylindrical object such as a lipstick (29, see also column 1 lines 54-56). Though Erdmann's functional language does not disclose supporting her invention under a garment by the cylindrical device, her device is structurally analogous to the enumerated claims and is intended for the similar use of

Art Unit: 3727

containing several small personal articles discreetly. The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Erdmann which is capable of being used in the intended manner, i.e., suspended by the cylindrical object under the clothing (see M.P.E.P. 2111). This reasoning applies to both claim 1 and claim 9.

With regard to claims 2 and 10, the storage sleeve for cylindrical objects is elastic (column 3 line 6).

With regard to claims 3, 4, and 13, the support may be cylindrical (column 3 line 2) and especially may be a lipstick container (column 3 line 1).

With regard to claims 6 and 15, Erdmann's assembly has a flap 16 covering the pocket opening.

With regard to claims 7 and 16, the pocket is formed by a single piece of material sewn at opposing sides (column 2 lines 45-48).

With regard to claims 11 and 12, the applicant's use of the terms "above" and "top" cannot define the instant device specifically enough to overcome the structural similarities of Erdmann. If Figure 1 in the Erdmann patent were turned upside down, it would clearly read on both claims.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3727

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdmann (US 6,321,958) in view of Pollak (US 2474495). Erdmann discloses the storage compartment 12, but does not mention a zipper closure for the compartment. Pollak teaches the use of a zipper to selectively close compartments in a personal item storage device in Figure 2 of his disclosure. It would have been obvious to one of ordinary skill in the art at the time of application to include a zipper feature in a fabric compartment meant to store small, important items.

7. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdmann (US 6,321,958) in view of O'Mara (US 4,736,853). While Erdmann provides an elastic loop connected to the pocket structure (Figure 3), it does not specify how that loop is connected. O'Mara teaches the sewing (column 2, line 41) of elastic loop supports 28, 30, and 32 to storage compartments for securely retaining cylindrical objects (column 2, line 66-68). It would have been obvious to one of ordinary

skill in the art at the time of invention to use sewing as a method of connecting elastic to fabric.

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdmann (US 6,321,958) in view of Freer (US 6,202,911). Erdmann discloses a storage compartment support member 14 and a pocket construction 12, but in Figure 1 the storage compartment is shown as oriented below the pocket. Freer's holder for small articles teaches a horizontal loop for containing cylindrical items positioned above a pocket framework. The scorecard pencil intended for stowage in the horizontal loop is capable of supporting the golf accessory organizer in a pendant manner. While Freer's device is meant to hold a scorecard pencil in the cylindrical object holder and golf balls in the pocket, the devices can be compared based on their similar uses for securing small articles to a person's clothing. It would have been obvious to one of ordinary skill in the art at the time of invention to place the support member above or on top of the pocket in order to hold articles in specific orientations.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harris et. al. (US D485,677) shows a related invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret L. Olson whose telephone number is (571) 272-9002. The examiner can normally be reached on MTWR, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER